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C performing one or more operations selected from the group consisting of sewing, stitching, welding, needling, fusing and gluing said overlying unlaminated portion of said top layer with said unlaminated portion of said bottom layer;

wherein the resulting papermaker's fabric has a sandwich structure, and wherein the surface of said top layer and the surface of said bottom layer that form the inner surfaces of said sandwich are (substantially) smooth.--

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REMARKS

This Amendment is responsive to the Office Action dated July 8, 2002. Claims 1 and 7-32 were pending in the application. In the Office Action, claims 1 and 7-32 were rejected. In this Amendment, claims 1 and 22 have been amended. Claims 1 and 7-32 thus remain for consideration.

Applicant submits that the application is now in condition for allowance and requests reconsideration and withdrawal of the rejections in light of the following remarks.

\$112 Rejections

Claims 1 and 7-32 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Applicant has amended independent claims 1 and 22, and submits that the amendments to claims 1 and 22 render claims 1 and 7-32 compliant with §112. Accordingly, Applicant requests that the rejections under §112 be withdrawn.

§102 and §103 Rejections

Claims 1 and 7-32 were rejected under 35 U.S.C. §102(b) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as obvious over Baker et al. (EP 802280) or under 103(a) as obvious over Baker as necessary with Rexfelt et al. (EP 665329) and/or Best (EP 464258).

Applicant submits that the independent claims (claims 1 and 22) are patentable over Baker, Rexfelt and Best.

Applicant's invention as recited in the independent claims is directed toward a papermaker's fabric and a method for making such a fabric. Each of the claims recites that the fabric is formed from a laminated structure having a top layer and a bottom layer, that "the resulting papermaker's fabric has a sandwich structure," and that "the surface of said top layer and the surface of said bottom layer that form the inner surfaces of said sandwich are substantially smooth."

Neither Baker, Rexfelt nor Best discloses a papermaker's fabric having a sandwich structure wherein the surface of the top layer and the surface of said bottom layer that form the inner surfaces of the sandwich are substantially smooth. In particular, Applicant wishes to comment on the Baker reference.

Baker discloses an industrial fabric having segments with integral jointing structures. The jointing structures engage with, and interlock with, each other to provide secure mating engagement of the segments making up the fabric (see e.g. Baker column 3, lines 5-16). The jointing structures of Baker give the joining surfaces of Baker's segments an unsmooth profile, thereby teaching away from Applicant's invention. Indeed, Baker discusses drawbacks associated with the joining of prior art smooth-surface segments (see e.g. column 2, line 14 to column 3, line 3), and how the interlocking of unsmooth surfaces can be used overcome those drawbacks (see e.g. column 2, lines 26-35).

Regarding the rejections under §102 based on Baker, it is respectfully pointed out that a two-prong inquiry must be satisfied in order for a Section 102 rejection to stand. First, the prior art reference must contain all of the elements of the claimed invention. See *Lewmar Marine Inc. v. Barient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Second, the prior art must

contain an enabling disclosure. *See Chester v. Miller*, 15 U.S.P.Q.2d 1333, 1336 (Fed. Cir. 1990). A reference contains an enabling disclosure if a person of ordinary skill in the art could have combined the description of the invention in the prior art reference with his own knowledge of the art to have placed himself in possession of the invention. *See In re Donohue*, 226, U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Baker does not contain all of the elements of the claimed invention. At the very least, Baker does not disclose a sandwich structure wherein the inner surfaces of the sandwich layers are substantially smooth. Baker's column 7, lines 10-35 mentions that the plies of each segment can be interconnected by "tie-strands." However, the coupling of the segments to each other is still achieved by way of interlocking jointing structures (e.g. slots and ribs).

Moreover, even if Baker could be construed as suggesting a sandwich structure wherein the inner surfaces of the sandwich layers are substantially smooth, it could not be construed to contain enabling disclosure for forming such a structure. The interlocking structures of Baker must be properly aligned in order to be effective. For example, the ribs and slots on a first surface must be aligned with the ribs and slots on a mating surface, otherwise the surfaces will not interlock. By contrast the substantially smooth surfaces of Applicant's

invention are not attached by interlocking, but rather, by sewing, stitching, welding, needling, fusing and/or gluing; and therefore Applicant's surfaces do not need to be mechanically aligned, allowing for some shift in the relative positions of the layers during construction. Baker is limited to mechanical alignment because of incorporates an interlocking structure that only interlocks when properly aligned, and thus Baker can not possibly be construed as disclosing an alignment independent structure.

Regarding the rejections under §103, it is well-settled that there must be some prior art teaching which would have provided the necessary incentive or motivation for modifying the reference teachings. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (B.P.A.I. 1993). Further, "obvious to try" is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification." Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be

founded in the prior art, and not Applicant's disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

In the present case, Baker does not provide the necessary incentive or motivation for modifying its interlocking structure to form a smooth-surfaced structure as recited by Applicant. Indeed, Baker teaches away from such modification by requiring mechanical alignment of its interlocking joints. Again, the Federal Circuit in *In re Fine* was very clear that "obvious to try" is not the standard upon which an obviousness rejection should be based. And as "obvious to try" would be the only standard that would lend the instant rejection any credibility, the rejection must fail as a matter of law.

Furthermore, Applicant emphasizes that the only expectation of success is found in Applicant's specification. The Baker disclosure stands in stark contrast. Not only does Baker fail to mention any possibility of success with a smooth-surfaced structure, it is predicated on solving the problems associated with such structures (see e.g. Baker column 2, line 14 to column 3, line 3).

In sum, since neither Baker, Rexfelt nor Best discloses a papermaker's fabric having a sandwich structure wherein the surface of the top layer and the surface of said bottom layer that form the inner surfaces of the sandwich are substantially smooth, Applicant believes that claims 1 and 22

are patentable over Baker, Rexfelt and Best - taken either alone or in combination - on at least this basis.

Claims 7-21 depend on claim 1. Since claim 1 is believed to be patentable over the cited references, claims 7-21 are believed to be patentable over the cited references on the basis of their dependency on claim 1.

Claims 23-32 depend on claim 22. Since claim 22 is believed to be patentable over the cited references, claims 23-32 are believed to be patentable over the cited references on the basis of their dependency on claim 22.

Applicant submits that all of the claims now pending in the application are in condition for allowance, which action is earnestly solicited.

It is submitted that these claims, as originally presented, are patentably distinct over the prior art cited by the Examiner, and that these claims were in full compliance with the requirements of 35 U.S.C. §112. Changes to these claims, as presented herein, are not made for the purpose of patentability within the meaning of 35 U.S.C. §§101, 102, 103 or 112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicant is entitled.

Statements appearing above with respect to the disclosures in the cited references represent the present opinions of the Applicant's undersigned attorney and, in the event that the Examiner disagrees with any such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the respective reference providing the basis for a contrary view.

The Examiner is hereby authorized to charge any insufficient fees or credit any overpayment associated with the above-identified application to Deposit Account No. 50-0320.

The Examiner's consideration of this matter is gratefully acknowledged.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

Claims 1 and 22 have been amended as follows:

--1(twice amended). A method for manufacturing a papermaker's fabric, said method comprising the steps of:

providing a laminated structure, said laminated structure having a bottom layer and a top layer, said bottom layer and said top layer each being strips of equivalent width and being laminated together, said bottom layer being transversely offset with respect to said top layer so that an unlaminated portion of said bottom layer is along one lateral edge of said laminated structure and an unlaminated portion of said top layer is along the other lateral edge of said laminated structure;

spirally winding said laminated structure in a plurality of turns wherein said unlaminated portion of said top layer in one turn of said laminated structure overlies said unlaminated portion of said bottom layer in an adjacent turn of said laminated structure; and

joining said overlying unlaminated portion of said top layer to said unlaminated portion of said bottom layer to form said papermaker's fabric, said joining including one or more operations [excepting interlocking said overlying unlaminated portion with said top layer to said unlaminated portion of said bottom layer and being] selected from the group consisting of

sewing, stitching, welding, needling, fusing and gluing said overlying un laminated portion with said top layer to said un laminated portion of said bottom layer, and said papermaker's fabric being in the form of an endless loop having an inner surface and an outer surface;

wherein the resulting papermaker's fabric has a sandwich structure, and wherein the surface of said top layer and the surface of said bottom layer that form the inner surfaces of said sandwich are substantially smooth.

22 (twice amended). A papermaker's fabric for a paper machine, said papermaker's fabric comprising:

a laminated structure, said laminated structure having a bottom layer and a top layer, said bottom layer and said top layer each being strips of equivalent width and being laminated together, said bottom layer being transversely offset with respect to said top layer, so that an un laminated portion of said bottom layer is along one lateral edge of said laminated structure and an un laminated portion of said top layer is along the other lateral edge of said laminated structure; said laminated structure being spirally wound in a plurality of turns wherein said un laminated portion of said top layer in one turn of said laminated structure overlies said un laminated portion of said bottom layer in an adjacent turn of said laminated

structure; said overlying unlaminated portion of said top layer being joined to said unlaminated portion of said bottom layer by performing one or more operations [excepting interlocking said overlying unlaminated portion of said top layer with said unlaminated portion of said bottom layer and being] selected from the group consisting of sewing, stitching, welding, needling, fusing and gluing said overlying unlaminated portion of said top layer with said unlaminated portion of said bottom layer;

wherein the resulting papermaker's fabric has a sandwich structure, and wherein the surface of said top layer and the surface of said bottom layer that form the inner surfaces of said sandwich are substantially smooth.--